

Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-23 are pending in the application, with claims 1, 12, 13, 16, and 22 being the independent claims. Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 102

In the Office Action, claims 1-23 were rejected under 35 U.S.C. §102(e) as being anticipated by Patterson, et al, U.S. Patent Application No. 20040036575 (Patterson). Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631 (Fed. Cir. 1987). Patterson does not expressly teach or inherently describe each and every element in independent claims 1, 12, 13, 16, and 22.

Independent claims 1 and 12 recite a method including the steps of "(1) evaluating a confirmed read flag, (2) if the confirmed read flag indicates the tag has been previously read, transitioning the operating state to a dormant state, and (3) if the confirmed read flag indicates that the tag has not been previously read, transitioning the operating state to the second state."

Independent claim 13 recites a method including the step of "if the [received] symbol has the first logic value, setting the confirmed read flag to indicate that the tag

has been read." Independent claim 16 recites an RFID tag including "means for storing a confirmed read flag that indicates whether the tag has been recently read."

In the Office Action, the Examiner refers to FIG. 2 and 3 of Patterson as describing at least these elements of independent claims 1, 12, 13, and 16. In these figures, the reader reads the tag data in step 16 and in step 18 the tag is turned off. However, Patterson does not expressly state how the tag is turned off. Patterson certainly does not expressly describe that the tag evaluates a confirmed read flag, and if the confirmed read flag has been previously read, transitioning the operating state to a dormant state. Furthermore, Patterson does not expressly describe the setting of a confirmed read flag to indicate that the tag has been read or a means for storing a confirmed read flag that indicates whether the tag has been recently read. Patterson simply does not expressly teach or even suggest the use of a stored data value in a tag to indicate that a tag has been read.

In the Response to Arguments, the Examiner states that "[t]ag is turned off (step 18) only after the tag has been read. In order to perform that operation, the tag must store data, which indicates that the tag has been read." (Office Action, p. 6). Thus, the Examiner seems to be arguing that the elements of claims 1, 12, 13, and 16 described above are inherent in Patterson.

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result

from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

A tag may be turned off in a wide variety of ways. For example, a tag may turn itself off after transmitting its tag data to the reader. In a further example, a tag may turn itself off after receiving a signal from the reader, without evaluating any data stored in the tag. A tag may further be turned off when power to the tag is lost. Thus, the steps of "(1) evaluating a confirmed read flag, (2) if the confirmed read flag indicates the tag has been previously read, transitioning the operating state to a dormant state, and (3) if the confirmed read flag indicates that the tag has not been previously read, transitioning the operating state to the second state," as recited in independent claims 1 and 12 are not necessarily present in Patterson.

Similarly, it is not necessary for a tag to set or store information indicating that it has been read. Therefore, the step of "if the symbol has the first logical value, setting the confirmed read flag to indicate that the tag has been read," as recited in independent claim 13 and the "means for storing a confirmed read flag that indicates whether the tag has been recently read," as recited in independent claims 13 and 16, respectively, are not necessarily present in Patterson.

Furthermore, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)(emphasis in original). Applicants respectfully request that if the Examiner maintains the anticipation

rejection that the Examiner provide either *facts and/or technical reasoning* establishing how at least the above claim limitations are *necessarily present* in Patterson.

Independent claim 22 recites "(a) determining whether an interrogation of all tags in the population of tags is required or whether an interrogation of only unread tags is required; if it is determined in step (a) that all tags in the population of tags are to be interrogated, transmitting a first symbol to the population of tags; and (c) if it is determined in step (a) that only unread tags are to be interrogated, transmitting a second symbol to the population of tags."

In the rejection of independent claim 22, the Examiner refers to the following passage of Patterson:

Alternatively as illustrated in FIG. 3, the RFID reader can send a signal to turn on all tags at 22. And, as illustrated in FIG. 4, the RFID reader can send a signal to a specific tag or a specific group of tags to turn-on only that tag or tags. For example, when an RFID reader, which also writes data, has changed tag data on a selected tag or tags, the new tag data can be verified without having to rereading [sic] all of the tags in a giving area.

(Office Action, p. 5, citing Paragraph 0021 of Patterson). However, nothing in this passage or in Patterson, taken as a whole, teaches or suggests that a reader interrogates tags based on their status as read or unread. As described above, Patterson does teach or suggest, nor is it inherent in Patterson, that a tag stores an indication that it has been previously read. Without such stored data, a reader would not be able to interrogate tags based on their status as read or unread.

In the Office Action, the Examiner agreed with the Applicants' argument, filed on November 22, 2005, that tags can be "off" without previously being read for a wide variety of reasons. (Office Action, p. 5). Therefore, the fact that a tag is "off" is not an

indication that the tag has been read. In addition, the fact that a tag is "off" is not an indication that the tag has not been read.

Thus, Patterson does not teach or in any way suggest a method in reader including the steps of "(a) determining whether an interrogation of all tags in the population of tags is required or whether an interrogation of only unread tags is required; if it is determined in step (a) that all tags in the population of tags are to be interrogated, transmitting a first symbol to the population of tags; and (c) if it is determined in step (a) that only unread tags are to be interrogated, transmitting a second symbol to the population of tags," as recited in independent claim 22.

Based on the foregoing, Applicants submit that Patterson does not expressly teach or inherently describe each and every limitation of independent claims 1, 12, 13, 16, and 22. Thus, for at least these reasons, Patterson does not anticipate independent claims 1, 12, 13, 16, and 22. Reconsideration and withdrawal of this ground of rejection is therefore respectfully requested.

Claims 2-11 depend from claim 1, claims 14 and 15 depend from claim 13, claims 17-21 depend from claim 16, and claim 23 depends from claim 22. For at least the reasons described above in regards to claims 1, 12, 13, 16, and 22, and further in view of their own features, claims 2-11, 14, 15, 17-21, and 23 are patentable over Patterson. Reconsideration and withdrawal of this rejection is therefore respectfully requested.

Conclusion

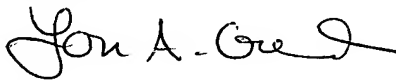
All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the

Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Lori A. Gordon
Attorney for Applicants
Registration No. 50,633

Date: AUGUST 17, 2006

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

537311_1.DOC